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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,349	07/28/2003	Richard J. Korane	T0520.70001US00	6347

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Boston, MA 02210

EXAMINER
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PIAZZA CORCORAN, GLADYS JOSEFINA

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 09/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/629,349

Applicant(s)

KORANE ET AL.

Examiner

Gladys JP Corcoran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-42 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-8, drawn to a method of repairing a dry-erase surface, classified in class 156, subclass 94.
  - II. Claims 9-16, drawn to a method of transforming a writing surface into a dry erase surface, classified in class 156, subclass 60.
  - III. Claims 17-25, drawn to a dry erase surface, classified in class 428, subclass 409.
  - IV. Claims 26-29, drawn to an article, classified in class 428, subclass 40.1.
  - V. Claim30-34, drawn to a method of writing, classified in class 101, subclass 483.
  - VI. Claim35-42, drawn to a kit, classified in class 206, subclass 223.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are directed to I repairing a dry erase surface and II transforming a writing surface to a dry erase surface. They have different modes of operation (repair versus transformation), different functions (repair versus transformation) and different effects (repair versus transformation).

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3. Inventions I and III are related as process of repairing a product and the product.

The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process as claimed is for repairing a product which does not require the particulars of the product claimed and can be used to repair other and materially different products. Additionally the product as claimed can be made by another and materially different process (there is no need for repair steps).

4. Inventions I and IV are related as process of repairing a product and the product

made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process as claimed is for repairing a dry erase surface which does not require the particulars of the product claimed (that the dry erase surface being repaired have an adhesive surface and can be used to repair other and materially different products). Additionally the product as claimed can be made by another and materially different process, the adhesive could be coated to the second sheet prior to applying the first sheet.

5. Inventions I and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are directed to I repairing a dry erase surface

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and II writing on a first sheet of a stack of sheets. They have different modes of operation (repair versus writing), different functions (repair versus writing) and different effects (repair versus writing).

6. Inventions I and VI are related as process and kit for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced with another materially different kit or by hand, or (2) the kit as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process does not require the instructions as claimed in the kit and the kit can be used to practice another and materially different process such as applying the sheet to a surface other than a dry erase surface.

7. Inventions II and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process as claimed is for transforming a writing surface to a dry erase surface which does not require the particulars of the product claimed and can be used to transform other and materially different products. Additionally the product as claimed can be made by another and materially different process (there is no need for transformation).

8. Inventions II and IV are related as process of transforming a product and the product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially

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different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process as claimed is for transforming a writing surface to a dry erase surface which does not require the particulars of the product claimed (that the writing or dry erase surfaces have an adhesive surface and can be used to transform other and materially different products). Additionally the product as claimed can be made by another and materially different process, the adhesive could be coated to the second sheet prior to applying the first sheet.

9. Inventions II and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are directed to I transforming a writing surface and II writing on a first sheet of a stack of sheets. They have different modes of operation (transforming versus writing), different functions (transforming versus writing) and different effects (transforming versus writing).

10. Inventions II and VI are related as process and kit for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced with another materially different kit or by hand, or (2) the kit as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process does not require the instructions as claimed in the kit and the kit can be used to practice another and materially different process such as applying the sheet to a surface other than a writing surface.

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11. Inventions IV and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the sheets in the stack do not require the particular properties of the dry erase surface claimed. The subcombination has separate utility such as a dry erase surface without the need to be stacked nor with an adhesive bottom surface.

12. Inventions V and III are related as process of writing and a product. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process as claimed is for writing on a dry erase surface on a stack of sheets which does not require the particulars of the product claimed (that the dry erase surface has the properties claimed). Additionally the product as claimed can be made by another and materially different process, the writing process does not produce the dry erase surface.

13. Inventions VI and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP §

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806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the dry erase sheet does not require the particular properties of the dry erase surface claimed. The subcombination has separate utility such as a dry erase surface without instructions.

14. Inventions IV and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process such as removing the first sheet and then writing.

15. Inventions IV and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are directed to I an article stack and II a kit. They have different modes of operation (a stack of sheets versus kit with a sheet and instructions), different functions (a stack of sheets versus kit with a sheet and instructions) and different effects (a stack of sheets versus kit with a sheet and instructions).

16. Inventions V and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In



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the instant case the different inventions are directed to I method of writing and II a kit.

They have different modes of operation (a method of writing on a stack of sheets versus a kit with a sheet and instructions), different functions (a method of writing on a stack of sheets versus a kit with a sheet and instructions) and different effects (a method of writing on a stack of sheets versus a kit with a sheet and instructions).

17. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

18. Because these inventions are distinct for the reasons given above and the search required for the Groups is not required for other Groups, restriction for examination purposes as indicated is proper.

19. This application contains claims directed to the following patentably distinct species of the claimed invention:

Should Applicant elect Group II, Applicant must also elect one of the following Species from each Subset:

Subset I:

**Species A**, where the writing surface is a chalkboard, apparently claim 12.

**Species B**, where the writing surface is paper, apparently claim 13.

Subset II:

**Species X**, where the adhesive is removable, apparently claims 14, 15.

**Species Y**, where the adhesive is repositionable, apparently claims 14, 15.

**Species Z**, where the adhesive is permanent, apparently claim 14.

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Applicant is required under 35 U.S.C. 121 to elect a single disclosed species from each subset for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 9-11, 16 are generic.

Applicant is advised that a reply to this requirement **must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added.**

An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

20. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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21. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gladys JP Corcoran whose telephone number is (571) 272-1214. The examiner can normally be reached on M-F 8am-5:30pm (alternate Fridays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dunn can be reached on (571) 272-1171. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Gladys JP Corcoran  
Primary Examiner  
Art Unit 1733

GJPC